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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,215	08/28/2000	Allan Lamkin	68570	7416
22242	7590	03/28/2006	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			VU, TUAN A	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/649,215		LAMKIN ET AL.	
	Examiner		Art Unit	
	Tuan A. Vu		2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/05; 9/12/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

DETAILED ACTION

1. This action is responsive to the application filed 1/17/2006.

Claims 1-10 have been submitted for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a “useful, concrete, and tangible result” be accomplished. An “abstract idea” when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”.

Specifically, claim 9 recites a system comprising a parser, a image engine, and formatter.

From scanning the specifications, these entities are reasonably conveyed as being software implemented functional elements to carry out their functionality as recited in the claim.

However, a system claim is not a process claim; and should include sufficient hardware so as to support the functionality being conveyed in the claim as recited. The claim amounts to listing of software entities (which appear to be functional) but there is absence of tangible hardware structure or embodiment to support these entities in order to carry their functionality or to enable their functionality to be realized. The system claim is thus rejected as reciting non-statutory functional descriptive material.

Claim 10 recites a software system including a search module, a content generating module, an image generating module and a formatting module. As in claim 9, above, these modules appear to be software implemented as reasonably conveyed from the Specifications. As noted above, this software system claim lacks hardware structure to support the functional modules; and is thus rejected as reciting non-statutory functional descriptive material.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim 7 recites ‘searching in response to the insertion of a DVD into ... device’. As scanned from the specifications, there are teachings about a “play insert button” being prompted to an user in a development mode of the product (Specifications, pg. 22) and about launching a DVD so that visual runtime options are offered in the browser or window mode to allow the user to launch an URL, to play a movie, or to navigate the content of the DVD (Specs. pg. 9-11) leading to a selecting for further aspects (e.g. “association”) of data manipulation therein. But there is no clear teaching that the searching step as recited in claim 1 (for a variable) being directly associated with a runtime insertion of a DVD into a device.

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Whereas the claim recites ‘searching in response to the insertion of a DVD...’, the specifications do not appear to show that by inserting a DVD into a machine, the (immediate) effect is that the looking for a variable would be triggered. Hence, one skill in the art would not be apprised on how the launching of a DVD (by way of the insertion thereof) can trigger looking of a variable when there are some numerous scenarios in-between that would be dependent of the user’s choice or selection of URL or launching screens/buttons (as proffered from pg. 9-11 of the Specifications). It appear as though the inventor is not in possession of the subject matter of claim 7 based on the above observations. The limitation will be treated as being an action taken in the runtime process to author a DVD media.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tahara et al., USPN: 5,909,551 (hereinafter Tahara)..

As per claim 1, Tahara discloses a method for combining video/audio content with programmatic content, comprising:

generating a authoring output, a representation of the video/audio content, the representation defining how the video/audio content is to be displayed (e.g. elements 2301, 2305, 2306, 2307 – Fig. 23; *display means* 507, 1006 - Fig. 10); the authoring output comprising

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definition of a variable (e.g. Fig. 27-28 – Note: IMG SRC=, A HREF= tags read on variable being defined)

replacing the variable with the definition for the variable (e.g. Fig. 27a, 27b; col. 17, lines 44-46; col. 17, line 41-52 to col. 18, line 8 – Note: variable enclosed and defined within markup tags and being replaced by corresponding html page/file or image data reads on replacing variable < ... /> with its definition being enclosed);

generating programmatic content (HTML 2306; PC 2307 – Fig. 23);

generating an image (Fig. 24; *image ... medium* - col. 16, lines 1-3) as a function of the programmatic content and representation of the video/audio content and combining the image with the video/audio content (e.g. col. 16, lines 15-55; col. 19 lines 1-57);

Tahara discloses storing source files in a directory structure wherein specific browser type of files are evoked from the user choosing of a button (e.g. *INDEX.HTML* - col. 17, line 34-40, 50-52); hence this choosing action by the user reads on selecting a source file.

Tahara does not explicitly disclose searching the source file for the variable. But Tahara discloses that each hyperlinked definition inside a markup source file (see Fig. 27-28) wherein a tagged variable is automatically processed and replaced (e.g. *data is displayed* - col. 17, lines 44-46; Fig. 24-26; col. 17, line 53 to col. 18, line 8 – Note: index.html tags or hyperlinked variables according to SGML/HTML standard read on variables being replaced) by various form of data -- for viewing purpose (step 1105 – Fig. 11; col. 16, lines 39-47; Fig. 26-28) in the user-driven interactive program. Thus, Tahara has disclosed replacing the variable with the definition for the variable. As for the searching of a hyperlinked variable defined in a markup source document (see Fig. 27a, 27b), the browser scanning through the hierarchy of the hypertext and resolving its

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HTML tags according to WWW standards for retrieving the defined data underlying such hyperlink (col. 16, lines 39-47) will read on search for definition of the hyperlink variable in the source file (col. 17, lines 44-46); hence Tahara discloses searching the source file for the variable owing to a inherent traversal of tree and look for tags in WWW/HTML tag processing by browser.

As for the limitation on 'generating programmatic content in response to said searching', Tahara discloses browser processing based on the user triggering of HTML file in which hyperlinked variables (e.g. col. 17, lines 56-64; Fig. 27) are set for defining external data or other source files (col. 18, lines 23-27, 46-52) which are to be displayed following the interactive selection by the user; and resolving of hyperlinked variables --from that browser in response to that selection --into displayed content to be finally stored or recorded into the different section of image medium 2301 (Fig. 23; col. 19 lines 1-57). Thus, Tahara has disclosed generating programmatic content (generating programmatic content (HTML 2306; PC 2307 – Fig. 23) in response to the searching based on browser processing of tagged link.

As per claim 2, Tahara discloses storage medium (Fig. 23)

As per claim 3, Tahara discloses transmission medium (Fig. 1, 23 – Note: hardware linking storage medium in computer reads on transmission medium)

As per claims 5 and 6, Tahara discloses searching at runtime (e.g. Fig. 26; *definition ...selection button ... linked to file ... INDEX.HTML, RETURN.GIF* - col. 17, line 53 to col. 18, line 8- Note: parsing HTML tags using a browser methodology reads on runtime browser)

As per claim 7, Tahara discloses executing a DVD being inserted (e.g. Fig. 2, 23)

As per claim 8, Tahara discloses a system for combining video/audio content with programmatic content, comprising means for:

replacing the variable with the definition for the variable (e.g. Fig. 27a, 27b; col. 17, lines 44-46; col. 17, line 41-52 to col. 18, line 8 – Note: variable enclosed and defined within markup tags and being replaced by corresponding html page/file or image data reads on replacing variable `< ... />` with its definition being enclosed);

generating programmatic content (e.g. *HTML 2306*; *PC 2307* – Fig. 23);
generating an image (Fig. 24; *image ... medium* - col. 16, lines 1-3) as a function of the programmatic content and representation of the video/audio content, the representation defining how the video/audio content is to be displayed (e.g. col. 16, lines 15-55; col. 19 lines 1-57); and
combining the image with the video/audio content (e.g. col. 16, lines 15-55; Fig. 23).

But Tahara does not explicitly disclose searching a source file for the variable prior to replacing the variable with its definition; nor does Tahara explicitly disclose generating programmatic content in response to said searching. However, this limitation has been addressed as being disclosed in claim 1 above.

As per claim 9, Tahara discloses a system for combining video/audio content with programmatic content, comprising:

a parser for replacing the variable with the definition for the variable (e.g. Fig. 27a, 27b; col. 17, lines 44-46; col. 17, line 41-52 to col. 18, line 8– Note: variable enclosed and defined within markup tags and being replaced by corresponding html page/file or image data reads on replacing variable `< ... />` with its definition being enclosed);

an image engine for generating programmatic content (e.g. *HTML 2306*; *PC 2307* – Fig. 23);

for generating an image (Fig. 24; *image ... medium* - col. 16, lines 1-3) as a function of the programmatic content and representation of the video/audio content, the representation defining how the video/audio content is to be displayed (e.g. col. 16, lines 15-55; col. 19 lines 1-57); and

a formatter for combining the image with the video/audio content (e.g. col. 16, lines 15-55; Fig. 23).

But Tahara does not explicitly disclose parser searching a source file comprising the variable prior to replacing the variable with its definition; nor does Tahara disclose generating programmatic content in response to said searching. However, this limitation has been addressed in claim 1 above.

As per claim 10, this claim is a system version of claim 1 and recites module to perform the limitations of claim 1; hence incorporates all the corresponding rejection as set forth therein.

Response to Arguments

8. Applicant's arguments filed 1/17/06 have been fully considered but they are not persuasive. Following are the examiner's observations in regard thereto.

Rejection 35 USC § 103:

(A) Applicants have submitted that the 'generated files' by Tahara are not generated but in response to a searching (Appl. Rmrks, pg. 4, top para) and that there is no generation of programmatic content in response to any searching (Appl. Rmrks, pg. 4, 2nd para). The current rejection has it explained that Tahara's browser processing of tags in a HTML file reads on

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searching for a variable being defined; and based on the replacement of such definition with content being rendered for a user's viewing (see col. 17, line 40 to col. 18, line 52). The rejection has also pointed out that after selecting the different image or external data that have been rendered as a result of the HTML tags processing, the user stores these content in sections of the medium of Fig. 23, area 2305, 2307, and 2307; at least 2 among which (e.g. HTML 2306; PC 2307) read on programmatic content. Hence, there is teaching of a traversal of tags and looking for data being defined under the hyperlinked variables, and based on the ensuing rendering (or replacement with definition of such variables) of content as a result of such tag processing, such content is being accepted by the user and therefore stored in the medium wherein some of this content is programmatic (col. 19, lines 1-34). In other words, a variable is being searched and the definition of which is replaced with appropriate data for the user to view in order to whether or not store (Note: selectively storing and assembling data fetched from various sources – see Fig. 14-15 - into a final content reads on generating of such content, i.e. no preexisting content is maintained in the CD medium after such customized action) such as one of the plurality of programmatic parts of the delivered medium as set forth in the image of Fig. 23. The 'searching ... generating as a response ... programmatic content' limitation is thus disclosed. That is, the end result of the process of searching and replacing of HREF tag from various source data (i.e. *in response to*) as mentioned above yields (i.e. *generating ... programmatic content*) a storable content being generated and pictured in Fig 23. How the generating is done in terms of strict timetable (with respect to the gathering of additional source data when processing a HTML tag files) between the programmatic content as shown and the parsing leading thereto is not evident from the language of the claim because the claim does not

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provide further teaching but merely states 'generating programmatic content ... in response to the searching'. As a result, the office action has met such limitation.

(B) Applicants have submitted that the Office's attempted to equate Tahara's HTML links with the variable definition replacement as claimed, i.e. Tahara's assessing of the HTML content being equivalent to replacing variables with definitions as claimed; and there is no replacing in the resulting linked content with the definition of such link by Tahara (Appl. Rmrks, pg. 4, 3rd para; pg. 5, top 2 para) because the content is already accessed; and that one skill in the art would not replace such variable in the HTML content with a link. In response, the fact that the HREF are links do not take away the fact that data processed inside those tags are being used after the processing as data fetched from the very resolving of these tags content. That is, if the original data are used in terms of the data that represent them via a tag resolving process, the original data have been viewed as being substituted with its definition. The limitation of a variable being replaced with its definition reads exactly as just described. The claim does not make it explicitly and abundantly clear as to how this replacement is implemented in order for the above HREF tag resolving to read away from what Applicant believes to be his invention. There must be more specifics as to what the final result would be in terms of content after the replacing has taken place; the relationship between the original variable and the definition thus doing the replacing, and as to how this relationship is formatted or used in time-and-space terms within the context of programmatic content in relation with the parsing process applied to the source file having the variable. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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(C) Applicants have submitted that the Office has dissociated the cooperation of the claim features (Appl. Rmrks, pg. 5, 3rd para). The current rejection has made it clear that the variable is the hyperlinked variable in the opened HTM file triggered by the user selection; and the ensuing action using the browser to shift to different contents based on the action of the user is performed by the inherent tag processing which includes search and replacing of found tags definition with its content as set forth above. The resulting effect of such search and content rendering is enabling the user to store such content one by one into the programmatic portion of the final delivered medium. From what is taught in Tahara, when a user-triggered action takes place in light of a directory (Fig. 2; Fig. 15) storing the content to be retrieved via the HTML page opening and tag resolving, the effect of searching would be inherent because otherwise no data would be found and mapped against the HTML markup HREFs tags to yield Tahara's programmatic content of Fig. 23. As for the link not being equivalent to a replacement as claimed, this issue has been addressed above in section B.

(D) Applicants have submitted that the Office Action has equated 'authoring output' with 'programmatic content', a result from impermissible reading from the claim (Appl. Rmrks, pg. 6, middle). The grounds as to why such point is raised seem unclear. If the 'authoring output' is interpreted as a superset and the 'programmatic content' as a subset thereof, then there is nothing impermissible in the fact that the office action cites more elements from Tahara for the first and less for the second; unless the claim makes it very clear that 'authoring output' necessarily excludes 'programmatic content'; which is not the case. Thus the argument is unfounded. The arguments on claims 8-10 will be referred to the above sections in light of the rationale as set forth therein and further based on broad interpretation from one skill in the art in light of

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explicit and implicit teachings at the time the invention was made and of known concepts in the useful arts.

For the above reasons, the claims stand rejected as set forth in the Office Action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence - please consult Examiner before using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Tuan A Vu
Patent Examiner,
Art Unit 2193
March 09, 2006

A handwritten signature in dark ink, appearing to read "Tuan A Vu", followed by a long horizontal line extending to the right.

Continuation of Attachment(s) 6). Other: IDS: 10/24/05;11/9/05;11/15/05;11/30/05; 2/01/06 .